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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,597	06/29/2001	Michael E. Gardi	23952-0143	6502

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EXAMINER

OYEBISI, OJO O

ART UNIT PAPER NUMBER

3628

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/893,597		GARDI ET AL.	
	Examiner		Art Unit	
	OJO O. OYEBISI		3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In the amendment filed on 06/19/06, the following have occurred: claims 1, 8, 13, 20, and 25 have been amended, claims 1-25 remain pending, and claims 1-25 stand rejected in this office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the invention as now claimed i.e., **wherein the qualification information does not include financial factors associated with** the received billing information, historical billing information associated with the customer..... More specifically, the specification, as originally filed, does disclose "unlike billing systems which target customers for receipt of supplemental information based solely upon financial factors, such as billing history and credit criteria, the methods and systems of the present invention provide automated techniques for billers and others to target customers based upon any information they maintain or have access to about customers." That is to say, the qualification information not only includes **financial**

factors associated with the received billing information, historical billing information associated with the customer, but also includes any information they maintain or have access to about customers.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 13-19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (Walker hereinafter, US PAT: 6,196,458) in view of Katz et al (Katz hereinafter, US PAT: 6,055,513)

Re claim 1. Walker discloses a method for presenting customer-specific supplemental information with billing information, comprising: receiving billing information associated with a customer of a biller (see abstract); determining if the customer qualifies for presentment of a supplemental information item based upon qualification information based on billing information, historical billing information associated with the customer, or credit information associated with the customer (see abstract); generating a bill presentation; and presenting the generated bill presentation to the customer (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40); wherein, if the customer is determined to qualify for

presentment of the supplemental information item, the generated bill presentation includes the received billing information and the supplemental information item (see col.5 lines 23-40); and wherein, if the customer is determined not to qualify for presentment of the supplemental information item, the generated bill presentation includes the received billing information and excludes the supplemental information item (the supplemental information item is only printed if certain conditions are met, see Walker, Abstract. Thus, it's common sense to note that if these conditions are not met, then the received billing statement would exclude supplemental information Item). Walker does not explicitly disclose determining if the customer qualifies for presentment of a supplemental information, **wherein the qualification information does not include financial factors associated with** the received billing information, historical billing information associated with the customer, or credit information associated with the customer. However, Katz makes this disclosure (i.e., demographic information such as: age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers, see col.10 lines 1-25). Thus, it would have been obvious to combine Walker and Katz to provide responsive, effective information for the upsell determination.

Re claim 13. Walker discloses a system for presenting customer-specific supplemental information with billing information, comprising: a first processor configured to transmit billing information associated with a customer of a biller (i.e., merchant terminals/computer, see col.3, lines 63-67); and a second processor configured (i.e., central controller, see col.3, lines 63-67) to 1) receive the transmitted billing information,

2) determine if the customer qualifies for presentment of a supplemental information item based upon qualification information such as received billing information, historical billing information associated with the customer, or credit information associated with the customer (see col.3, line63 through col.4 line 45, also see "central controller" in the abstract) 3) generate a bill presentation (i.e., if the billing items satisfy an upsell offer condition, determines an upsell corresponding to the upsell offer condition, and prints onto the billing statement indicia that specifies the upsell, see col.5 lines 23-40), and 4) present the generated bill presentation (see col.5 lines 23-40); wherein, if the customer is determined to qualify for presentment of the supplemental information item, the generated bill presentation includes the received billing information and the supplemental information item (see col.5 lines 23-40); and wherein, if the customer is determined not to qualify for presentment of the supplemental information item, the generated bill presentation includes the received billing information and excludes the supplemental information item (the supplemental information item is only printed if certain conditions are met, see Walker, Abstract. Thus, it's common sense to note that if these conditions are not met, then the received billing statement would exclude supplemental information Item). Walker does not explicitly disclose determining if the customer qualifies for presentment of a supplemental information item based upon qualification information, **wherein the qualification information does not include financial factors associated with** the received billing information, historical billing information associated with the customer, or credit information associated with the customer. However, Katz makes this disclosure (i.e., demographic information such as:

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age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers, see col.10 lines 1-25). Thus, it would have been obvious to combine Walker and Katz to provide responsive, effective information for the upsell determination.

Re claims 2, 14. Walker discloses the method of claim 1, wherein the supplemental information item is one of an advertisement, an upsell offer or a cross-sell offer (see abstract).

Re claims 3, 15. Walker further discloses the method of claim 1, wherein the determination is based upon at least one of 1) a relationship between the customer and the biller (i.e., some upsell offer conditions include the purchase of a predetermined product, or a purchase which exceeds a predefined price, see abstract and 2) prior customer behavior (i.e., previously purchased product, see abstract).

Re claims 4, 16. Walker further discloses the method of claim 1, wherein: the generated bill is an electronic bill presentation; and the electronic bill is presented via a network (i.e., computer network terminal, see col.3, lines 62-67).

Re claims 5, 17. Walker discloses the method of claim 1, wherein determining if the customer qualifies for presentment of the supplemental information item includes: transmitting a request to a customer relationship management system (i.e., central controller, see col.5, lines 22-27) to determine if the customer qualifies for presentment of the supplemental information item; and receiving a response from the customer relationship management system indicating one of 1) that the customer qualifies for presentment of the supplemental information item, or 2) that the customer does not

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qualify for presentment of the supplemental information item (see central controller, col.5, lines 20-40).

Re claims 6, 18. Walker discloses the method, wherein: the billing information is received from the biller by a bill aggregator (i.e., a credit card account issuer, see abstract); the customer relationship management system is maintained by the biller; and the generated bill presentation is presented by the bill aggregator (a credit card account issuer, see abstract).

Re claims 7, 19 . Walker further discloses the method of claim 1, wherein the customer is a first customer, further comprising: receiving information indicating a customer response to the presented supplemental information item (see col.8, lines 1-5). Walker does not explicitly disclose modifying the qualification information based on the received customer response information; receiving billing information associated with a second customer of the biller; determining if the second customer qualifies for presentment of the supplemental information item based upon the modified information; generating another bill presentation; and presenting the other generated bill presentation; wherein, if the second customer is determined to qualify for presentment of the supplemental information item, the other generated bill presentation includes the received billing information associated with the second customer and the supplemental information item; and wherein, if the second customer is determined not to qualify for presentment of the supplemental information item, the other generated bill presentation includes the billing information associated with the second customer and excludes the supplemental information item. However, Katz discloses modifying the

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qualification information based on the received customer response information;
receiving billing information associated with a second customer of the biller;
determining if the second customer qualifies for presentment of the supplemental
information item based upon the modified information; generating another bill
presentation; and presenting the other generated bill presentation; wherein, if the
second customer is determined to qualify for presentment of the supplemental
information item, the other generated bill presentation includes the received billing
information associated with the second customer and the supplemental information
item (i.e., "The results of the proffer response thereto may be utilized in the
modification or updating of the system for identifying later upsells", see col.11, lines 40-
45, also see "The system may be modified over time. For example, the success of
prior upsells of specific items may be further incorporated in the decision as to the
upsell offers 370. This modification of the rules over time may be either done
in real time, or on a periodic basis, such as in a batch mode. Further, the system may
receive data from users after the receipt and use of their obtained goods or services,
such as wherein the customer satisfaction with the goods and services is then
incorporated in the decision criteria for the upsell offer ", see col.26, lines 4-12); and
wherein, if the second customer is determined not to qualify for presentment of the
supplemental information item, the other generated bill presentation includes the billing
information associated with the second customer and excludes the supplemental
information item (the supplemental information item is only printed if certain conditions
are met, see Katz, Abstract. Thus, Katz's would obviously exclude supplemental

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information item if these conditions are not met). Thus, it would have been obvious to combine Walker and Katz to provide responsive, effective information for the upsell determination.

Re claim 25. Claim 25 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

5. Claims 8-12, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Munsil et al (Munsil hereinafter, US APT: 5,761,650).

Re claims 8-12. Katz further discloses a method for presenting customer-specific supplemental information with billing information, comprising: receiving billing information associated with a customer of a biller (i.e., billing data, see col.9, lines 20-26); determining if the customer qualifies for presentment of a first supplemental information item (i.e., utilize primary transaction data as factor for offering item of information, see abstract); determining if the customer qualifies for presentment of a second supplemental information item (i.e., the upsell determination may be repeated, or the previously determined second upsell may be offered, see col.26, lines 30-40); generating a bill presentation; and presenting the generated bill presentation to the customer; wherein, each determination is based upon qualification information that **does not include financial factors associated with** the received billing information, historical billing information associated with the customer, or credit information associated with the customer (i.e., demographic information such as: age, sex, family status, location, income, education etc can be used as qualification data to offer upsell

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to customers, see col.10 lines 1-25); wherein, if the customer is determined to qualify for presentment of the first supplemental information item and not the second supplemental information item, the generated bill presentation includes the received billing information and the first supplemental information item and excludes the second supplemental information item; wherein, if the customer is determined to qualify for presentment of the second supplemental information item and not the first supplemental information item, the generated bill presentation includes the received billing information and the second supplemental information item and excludes the first supplemental information item (i.e., If the upsell is consummated 356, the order may be confirmed. That confirmation may be printed, if desired. Further, the customer may be provided with a confirmation number. If a shipping/tracking unit 364 is utilized, the tracking information, and the mode of accessing that system, may be provided to the customer. In the event the upsell offer is not consummated, the user may be offered an alternative upsell 358. The alternative upsell may be determined before the initial upsell, or may be recomputed, wherein one of the inputs to the determination system includes the negative result from the first upsell offer. Optionally, the customer may be queried regarding their reaction, either positive or negative, with respect to the initial upsell offer, so as to provide yet further specific inputs to the upsell determination system, see col.25, lines 55-67); and wherein, if the customer is determined not to qualify for presentment of the first and the second supplemental information items, the generated bill presentation includes the received billing information and excludes the first and the second supplemental information items (the supplemental information item is only printed if certain conditions

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are met (see Katz, Abstract), Thus, Katz's would obviously exclude supplemental information Item if these conditions are not met). Katz does not disclose the method of prioritizing the supplemental information (i.e., first and second supplemental information) and printing the supplemental information on the available space according to their priority. However, Munsil makes this disclosure (see col.3, lines 1-30, see col.2, lines 1-25, also see the abstract). Thus, it would have been obvious to one of ordinary skill in the art to combine Katz with Munsil to avoid having the customer billing statement exceed the cost of first class postage.

Re claims 20-24. Katz discloses a system for presenting customer-specific supplemental information with billing information, comprising: a first processor configured to transmit billing information associated with a customer of a biller (i.e., fig.3 element 132); and a second processor configured (i.e., fig.3 element 110) to 1) receive the transmitted billing information (see col.16, lines 64-67), 2) determine if the customer qualifies for presentment of a first supplemental information item (i.e., utilize primary transaction data as factor for offering item of information, see abstract), 3) determine if the customer qualifies for presentment of a second supplemental information item (i.e., the upsell determination may be repeated, or the previously determined second upsell may be offered, see col.26, lines 30-40), 4) generate a bill presentation (i.e., generates outputs relating to possible upsells for the customers, see col.16, lines 64-67), and 5) present the generated bill presentation; wherein the second processor is further configured to make each determination based upon qualification information that **does not include financial factors associated with** received billing information, historical

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billing information associated with the customer, or credit information associated with the customer (i.e., demographic information such as: age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers, see col.10 lines 1-25); wherein, if the customer is determined to qualify for presentment of the first supplemental information item and not the second supplemental information item, the generated bill presentation includes the received billing information and the first supplemental information item and excludes the second supplemental information item; wherein, if the customer is determined to qualify for presentment of the second supplemental information item and not the first supplemental information item, the generated bill presentation includes the received billing information and the second supplemental information item and excludes the first supplemental information item (i.e., If the upsell is consummated 356, the order may be confirmed. That confirmation may be printed, if desired. Further, the customer may be provided with a confirmation number. If a shipping/tracking unit 364 is utilized, the tracking information, and the mode of accessing that system, may be provided to the customer. In the event the upsell offer is not consummated, the user may be offered an alternative upsell 358. The alternative upsell may be determined before the initial upsell, or may be recomputed, wherein one of the inputs to the determination system includes the negative result from the first upsell offer. Optionally, the customer may be queried regarding their reaction, either positive or negative, with respect to the initial upsell offer, so as to provide yet further specific inputs to the upsell determination system, see col.25, lines 55-67); and wherein, if the customer is determined not to qualify for presentment of the first and the

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second supplemental information items, the generated bill presentation includes the received billing information and excludes the first and the second supplemental information items (the supplemental information item is only printed if certain conditions are met (see Katz, Abstract), Thus, Katz's would obviously exclude supplemental information item if these conditions are not met). Katz does not disclose the method of prioritizing the supplemental information (i.e., first and second supplemental information) and printing the supplemental information on the available space according to their priority. However, Munsil makes this disclosure (see col.3, lines 1-30, see col.2, lines 1-25, also see the abstract). Thus, it would have been obvious to one of ordinary skill in the art to combine Katz with Munsil to avoid having the customer billing statement exceed the cost of first class postage.

Response to Arguments

Applicant's arguments filed on 06/19/06 have been fully considered but they are not persuasive. The applicant argues in substance that neither Walker nor Katz can determine if the customer qualifies for presentment of supplemental information based upon qualification information, **wherein the qualification information does not include financial factors associated with** the received billing information, historical billing information associated with the customer..... The applicant's argument is predicated on the notion that Walker requires analyzing billing items on a billing statement for purposes of providing upsell offers, and Katz is not even directed towards a billing system at all. First, the applicant's specification does not provide enough support for the newly added limitation i.e., **wherein the qualification information does**

not include financial factors associated with the received billing information, historical billing information associated with the customer. Assuming, arguendo, that the applicant's specification does provide enough support for this newly added limitation, Katz's teachings would still read on this limitation. Katz explicitly discloses that demographic information such as: age, sex, family status, location, income, education etc can be used as qualification data to offer upsell to customers, see col.10 lines 1-25. Thus, it is clear by deduction that since demographic information such as: age, sex, family status, location, income, education, do not include financial factors **associated with** the received billing information, historical billing information associated with the customer. Evidently, Katz can determine if the customer qualifies for presentment of supplemental information based upon qualification information, **wherein the qualification information does not include financial factors associated with** the received billing information, historical billing information associated with the customer..., and one of ordinary skill in the art would have been motivated to combine Walker and Katz to provide responsive, effective information for the upsell determination. Lastly, the examiner submits that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **OJO O. OYEBISI** whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **HYUNG S. SOUGH** can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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